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OFFICE OF PETITIONS

In re Application of	:	
Janne Linkola	:	
Application No. 09/915,009	:	DECISION ON PETITION
Filed: July 25, 2001	:	UNDER 37 C.F.R. §1.47(b)
Attorney Docket No. 2132-49PCON	:	
Title: METHOD AND SYSTEM	:	
FOR THE ROUTING OF SHORT	:	
MESSAGES	:	

This is in response to the petition under 37 CFR §1.47(b)¹, filed April 4, 2002.

The petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration

¹ A grantable petition under 37 CFR §1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that a complete copy of the application was sent or given to each of the non-signing inventors for review;
- (5) proof that each of the non-signing inventors refused to sign, or cannot be reached after diligent efforts;
- (6) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (7) proof of irreparable damage, and;
- (8) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63.

executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on July 25, 2001, without an executed oath or declaration and identifying Janne Linkola as the sole inventor. On September 4, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted", requiring an executed oath or declaration in compliance with 37 CFR §1.63 and a surcharge for the late filing of the oath or declaration. This Notice set a two-month period for reply.

In reply, applicant filed the original petition, along with the associated fee, the fee associated with the late filing of an oath or declaration, and a five-month extension of time to make timely this reply.

With the petition, the petitioner has provided the last known address of the inventor, a statement by a person having firsthand knowledge of the underlying events (Anni Vepsalainen, senior vice president of the assignee), and a declaration executed by Haire Laitinen and Tia Tuouinen, attorneys for the assignee.

The petitioner asserts that the non-signing inventor worked for the assignee during the relevant period of invention, and that a specification and declaration were mailed to his last known address.

Rule 47 applicant has met requirements (1) – (3), and (6) – (7) above.

Regarding the fourth requirement above, the statement of Ms. Vepsalainen, "we delivered the declaration together with specification to Janne Linkola²" fails to establish that a complete copy of the application papers was not sent to the non-signing inventor. Where a refusal of the inventor to sign the application papers is alleged, the Office requires the petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the specification, claims, drawings, and oath or declaration.³ As only the declaration and the specification was sent, the fourth requirement has not been met. On renewed petition, it should be established that a complete copy of the application was sent to the non-signing inventor.

Furthermore, the language cited above seems to suggest that an employee of the assignee other than the declarant mailed the package to the non-signing inventor. On renewed petition, the petitioner should submit a statement from a party having first-hand knowledge of the events.

Regarding the fifth requirement above, it follows that since it has not been shown that a complete copy of the application was sent to the inventor, one cannot refuse to sign something which one has not seen. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does

² Declaration of Vepsalainen, page 1.

³ See MPEP 409.03(d).

not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed⁴.

Regarding the eighth requirement above, the submitted declaration is not in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63. It is noted that two representatives of the assignee have executed the declaration on behalf of the non-signing inventor. First, although two people have executed this declaration, the pertinent info is only given for one party⁵. Secondly, the citizenship is listed as "Finnish", when the declarant should have written "Finland". On renewed petition, the petitioner should either provide an executed oath or declaration, or one that corrects the deficiencies set forth above.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanowski at (703) 305-0011.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

⁴ In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

⁵ If these two general counsel wish to execute the declaration on behalf of the non-signing inventor, the pertinent information for both will be required. See MPEP §§ 409.03(b), 409.03 (f), and 605.04(a).